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| 09/689,128      | 10/12/2000  | James P. Romano      | 438P786             | 8083             |

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EXAMINER

NGUYEN, LEE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2682

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/689,128

Applicant(s)

ROMANO ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The IDS filed 10/12/2000 has been considered and recorded in the file.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiderman (US 5,850,599).

Regarding claim 1, Seiderman teaches a portable credit card verification apparatus comprising: a cellular radio/telephone 646 having a built-in power supply for operation over a limited time period (col. 25, lines 59-61); a data terminal including credit card entry means (644, fig. 8); a cellular interface 642 through which said radio/telephone 646 and said data terminal 644 are operatively connected; circuitry for verifying authorized

credit card access and accepting credit payment over said radio/telephone (see processor, col. 1, lines 13-18, col. 2, lines 49-56, col. 3, lines 3-7 and 14-25); a rechargeable DC battery 732 external to both said radio/telephone and said data terminal (fig. 12); and wiring connecting said DC battery 732 to both said radio/telephone and said data terminal to supply power to extend the limited time period (fig. 12, connection between 732 and 646 and 645).

Regarding claim 11, Seiderman teaches a portable apparatus for wireless transmission and verification of credit card data, said apparatus comprising: a cellular radio/telephone 424 (credit card interface integrated, fig. 6, col. 24, lines 30-61); a data terminal 410 including a microcontroller 440; circuitry for verifying authorized credit card access and accepting credit payment over said radio/telephone (see processor, col. 1, lines 13-18, col. 2, lines 49-56, col. 3, lines 3-7 and 14-25); inherently a power supply providing the power to the apparatus; and wiring connecting said radio/telephone directly to said microcontroller for digital communication of data directly between said terminal and radio/telephone (col. 24, lines 30-61).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiderman in view of Meads (US 5,272,747).

Regarding claims 2-3, Seiderman does not teach at least one peripheral device including a printer connected to the data terminal and using the DC battery power supply. In an analogous art, Meads

teaches an interface for connecting peripherals including computer, fax machines (col. 8, line 2) and printer (col. 8, line 35) using power from the mobile pay phone connector. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to also include a printer to the apparatus of Seiderman in order to provide receipts as required.

Regarding claim 4, Seiderman as modified also teaches magnetically coded data (col. 8, line 51, Visa, MasterCard).

Regarding claims 5-10, Seiderman further teaches arrangement of the radio telephone, the interface, the DC battery and the plate as shown in figures 9 and 10. Seiderman does not teach specific arrangement of the components as claimed and the size of the plate. Shifting different locations of parts as well as changing in size is not significant to the claimed invention because it would not modify the operation of the apparatus. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to shift the location of parts and the alter the size of the plate as required in order to neatly organize the apparatus.

Regarding claim 12, the claims is interpreted and rejected for the same reason as set forth in claim 3.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/067,462. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claims 1 and 11, claim 1 of U.S. Patent'462 teaches a portable credit card verification apparatus comprising: a cellular radio/telephone (wireless transceiver); a data terminal including credit card entry means (see data terminal); inherently a cellular interface through which said radio/telephone and said data terminal are operatively connected; a rechargeable DC battery external to both said radio/telephone and said data terminal (see rechargeable DC battery); and wiring connecting said DC battery to both said radio/telephone and said data terminal to supply power to extend the limited time period (see wiring connecting).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

9. Applicant's arguments filed 12/18/2003 have been fully considered but they are not persuasive.



In the remarks, Applicant contends that Seiderman fails to teach "circuitry for verifying authorized credit card access and accepting credit payment over said radio/telephone".

In response, first this limitation is taught in the background of the present invention (see the specification page 1, lines 10-15). Second, Seiderman teaches that the processor of the apparatus checks the credit card number and expiration date and also determines if the card has been altered or forged (col. 2, lines 49-56). Seiderman further teaches that the processor cooperates with the carrier to do the validation of authentication and the billing (col. 3, lines 1-25 and lines 32-51). Therefore, Seiderman does teach the claimed limitation.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 3/25/04  
LEE NGUYEN  
Primary Examiner  
Art Unit 2682